

**REMARKS**

Claims 1-19 and 28-35 remain pending in the instant application. Claims 1-8, 11-17, 19 and 28 34 stand rejected; claims 9, 10, 18 and 35 are objected to. Claims 1, 11, 12 and 19 are amended. We believe that the above amendments and the remarks laid out herein below address and overcome each of the Examiner's rejections and objections. Numbered headings that follow the first heading herein below, entitled "Improper Final Rejection", reflect the numbering used in the final Office Action mailed 9 August 2005.

**Improper Final Rejection  
(Request for Withdrawal of Premature Final Rejection)**

The Examiner has made the 9 August 2005 Office Action final, stating that Applicant's amendments necessitated the new grounds of rejection (over U.S. Patent No. 6,514,655, issued to Bastiaens). We submit that this is a premature final rejection, because the Examiner presents a new grounds of rejection based upon a reference that was submitted in Applicant's Information Disclosure Statement of 4 August 2003. This IDS was timely submitted under 37 C.F.R. §1.97(b), without a fee.

"Under present practice, second or any subsequent actions on the merits shall be final, *except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on an information submitted in an information disclosure statement filed during the period set forth in 37 C.F.R. §1.97(c) with the fee set forth in 37 C.F.R. 1.17(p).*" MPEP 706.07(a), emphasis added.

Neither is a conjunction for "not either", which is "used preceding two alternatives joined by 'nor' to indicate that *both* did not happen or are not true" and is recognized as "a negative grammatical word that introduces or connects two people, things, or situations, *both* of which are excluded. Encarta® World English Dictionary, North American Ed., © 2005 Microsoft Corporation, emphasis added.

Therefore, according to MPEP, an action cannot be made final when the new ground of rejection is not necessitated by applicant's amendment, and it also cannot be made final when it is based on information in an IDS that was not submitted during the period set forth in 37 §C.F.R. 1.97(c). In other words, in order to make an action final, the new grounds of rejection

must be both necessitated by applicant's amendment and based on information submitted in an information disclosure statement filed under 37 C.F.R. §1.97(c).

Applicant submitted the Bastiaens reference in an IDS filed during the period set forth in 37 C.F.R. §1.97(b) and not 37 C.F.R. §1.97(c). The final rejection is therefore premature. Applicant requests reconsideration and withdrawal of the finality of this Office Action. Per MPEP 706.07(d), "If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection."

### 1-2. Rejection Maintained/Response to Arguments

The Examiner states that claims 1-3, 5, 12 and 14 are rejected under 35 U.S.C. §102(b) as being anticipated by Wilson, for reasons of record in the last Office Action mailed on March 14, 2005. For example, the Examiner states that prior arguments that Wilson does not recite a pavement tape are unconvincing, because "Wilson clearly teaches that the tape that is applied to a floor, which includes pavement". Final Office Action, p. 2, ¶2 under item 2.

We must disagree. The Examiner's assumption that Wilson teaches a tape applied to a floor which includes pavement is completely unsupported by Wilson. Wilson specifically teaches a seam protector for use "immediately *following* a resilient vinyl floor covering installation" (col. 4, lines 29-30, emphasis added). Wilson's seam protector would therefore be applied to the installed vinyl covering, not to any substrate beneath the vinyl. Furthermore, Wilson is completely silent as to pavement, as a substrate beneath vinyl or otherwise. Even if Wilson did mention pavement (it makes absolutely no mention thereof), Wilson's seam sealer protector is explicitly described as being "attached to the installed floor covering", Wilson col. 6, line 44. It is not, therefore, a pavement tape.

Wilson also fails to teach a pavement tape with a flexible tape body (indeed, as noted, Wilson does not teach pavement tape at all). Wilson's device is composed primarily of a cardboard blank. See, e.g., Wilson col. 5, lines 8-31 and FIGs. 1-7. Wilson's cardboard blank is backed only at its edges with adhesive tape. Wilson col. 4, lines 51-55. Those skilled in the art would not consider cardboard an inherently flexible material – for example, cardboard is not "capable of being bent repeatedly without injury or damage." The American Heritage® Dictionary of the English Language, 4th Ed., © 2000, Houghton Mifflin Company. Indeed,

Wilson must provide score lines so that the cardboard blank can be folded into its intended form. See Wilson col. 6, lines 50-52; col. 7, lines 20-22; col. 8 lines 14-16.

Respectfully, the Examiner appears to assume limitations not explicitly taught by Wilson, in order to render Applicants' claims. We contend that this is impermissible, at least because, in order to anticipate a claim, Wilson must teach every element of the claim and "*the identical invention must be shown in as complete detail as contained in the ... claim.*" MPEP 2131 citing *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 2 USPQ2d 1051 (Fed. Cir. 1987) and *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989), emphasis added.

Wilson fails to teach Applicants' identical invention, at least because Wilson's device is not a pavement tape for conveying information when affixed to pavement (as recited in Applicant's independent claims 1 and 12). In addition, Wilson's device does not have a flexible tape body.

Because Wilson does not teach a flexible tape body, we maintain that Wilson cannot teach a flexible tape body with a front face comprising at least one symbol that conveys information. The Examiner states "in response to applicant's argument at [*sic*] Wilson fails to teach the front face bearing at least one symbol, it is noted that Wilson clearly teaches the print being "caution: electrical wires" on its front surface and as acknowledged by the applicant in the remark section, page-11, third paragraph." Second Office Action, page 3, ¶1 and 2. Respectfully, whether or not Wilson recites print is not at issue. Wilson does not recite print on a tape body. Wilson teaches printed matter on a sub-center panel of a cardboard blank. See Wilson col. 5, lines 45-49; col. 8, lines 63-65; FIGs. 1, 3 and 4. Wilson's sub-center panels are not the same thing as Applicant's tape body. For example, there is absolutely no indication that Wilson's sub-center panels are backed with, incorporated with or otherwise inclusive of tape. Therefore, they are not equivalent to Applicant's tape body.

The only tape mentioned in Wilson is attached to tabs 2 and 4. Wilson col. 6, lines 19-20; see also FIGs. 1-4. Neither this tape nor the tabs are said, shown or suggested to include any printing. On the other hand, in at least one embodiment, Applicant's tape body is clearly described as having a printed symbol on its surface and an adhesive on its bottom. For example, as supported by the Specification: "This tape comprises a tape body 101 and a series of symbols

102 arrayed on the surface of the tape body," p. 5, ¶[0043], and "a layer of pavement tape adhesive 112 on the bottom of tape body 101" p. 10, ¶[0066].

Regarding the Examiner's statement on page 3 of the Final Office Action, we did not previously argue that "Wilson fails to teach the front face bearing at least one symbol." Rather, we argued that Wilson fails to teach the front face bearing at least one symbol that conveys commercial information, as in claim 12. "Commercial", as defined by at least two dictionaries, means "Of or relating to commerce." The American Heritage® Dictionary of the English Language, 4th Ed. © 2000, Houghton Mifflin Company; Merriam-Webster's Dictionary of Law, © 1996, Merriam-Webster, Inc. As the Examiner notes, "Wilson clearly teaches the print being "caution: electrical wires" on its front surface." Final Office Action, p. 3, ¶1. This is different from commercial information. For example, as supported by the specification and in agreement with the above definition, Applicant's commercial information may indicate a business, for example, "commercial information for the general direction, by opposite arrows, of "XYZ DRUG" and "ACME GAS". Specification, p. 12, ¶[0076].

In summary, Wilson fails to anticipate independent claims 1 and 12 at least because Wilson fails to teach a pavement tape, a flexible tape body, and a tape body with at least one symbol on a front face. Wilson additionally fails to teach at least one symbol that conveys commercial information (as in claim 12). Claims 1-3 and 5 depend from claim 1 and claim 14 depends from claim 12, and thus benefit from like argument. We therefore request withdrawal of the Examiner's rejection.

#### 3-4. Rejections Withdrawn

Applicant thanks the Examiner for his indication that the §102(b) rejection of claims 1-5, 7-8, 11-14, 16-17 and 19 due to Townsend has been withdrawn in view of the amendment filed 24 May 2005. We agree that Townsend does not anticipate these claims.

We also agree that claims 6 and 15 are non-obvious over Townsend, and we thank the Examiner for his similar indication of the withdrawal of the §103(a) rejection of these claims.

## 5. Response to Arguments

We appreciate the indication that Applicant's prior arguments with respect to claims 1-19 and 28-35 have been considered. We contend that the arguments and amendments presented herein serve to overcome the Examiner's new grounds of rejection.

### 6-7. Claim Rejections – 35 U.S.C. §112, First Paragraph

The Examiner rejects claims 1-19 as failing to comply with the written description requirement. In particular, regarding claims 1 and 12, the Examiner states that the phrase "wherein the front and rear faces do not overlap an end of the continuous elongated tape body"...is found to be a negative limitation and, as such is deemed to be new matter for lack of express support in the specification." Office Action p. 4, Item 7. We must disagree, for at least the following reasons:

First, the Examiner is respectfully reminded that "the current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. *So long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph.*" MPEP 2173.05(i), emphasis added. We contend that the phrase "wherein the front and rear faces do not overlap an end of the continuous elongated tape body" sets forth the boundaries of patent protection sought. However, in order to advance the prosecution of the instant application, the objectionable limitation has been re-phrased in positive terms. Amended claims 1 and 12 recite "wherein the front and rear faces are exposed at an end of the continuous elongated flexible tape body". We further request that the Examiner consider this limitation and propose alternate text if he finds this still insufficient, per MPEP 2173.02: "Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement."

Second, regarding the Examiner's assertion of lack of express support for the phrase in question, we note that "While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, *or inherent* disclosure. MPEP 2163(I)(B), emphasis added. We contend that the limitation of front and rear faces that do not overlap an end of the tape body is inherently disclosed in the

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specification, at least because the specification references the drawings, which show that front and rear faces do not overlap an end of the tape body. See, e.g., FIGs. 2, 6 and 7; Specification p. 3, ¶[0015]; p. 4 ¶[0020]-[0021]; pp. 8-9, ¶[0059]-¶[0063]. Furthermore, per MPEP 2163.06, "...information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter." The amendment to claims 1 and 12 constitutes the addition of information from the drawings into the claims, and is therefore acceptable and in compliance with 35 U.S.C. §112, first paragraph. Likewise, the present amendment to claims 1 and 12 ("wherein the front and rear faces are exposed at an end of the continuous elongated flexible tape body") complies with 35 U.S.C. §112, first paragraph. For example, FIGs. 6 and 7 show that front and rear faces of tape body 101 are exposed at an end of the tape body.

Amended claims 1 and 12 comply with 35 U.S.C. §112, first paragraph. Claims 2-11 and 13-19 depend from claims 1 and 12, respectively, and therefore benefit from like argument. Withdrawal of the Examiner's rejection is respectfully requested.

#### **8-9. Claim Rejections – 35 U.S.C. §112, Second Paragraph**

The Examiner next rejects claims 1-19 and 30 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. We respectfully disagree, and we request withdrawal of the Examiner's rejection of claims 1-19 and 30, for at least the reasons laid out herein below.

The Examiner first states that the phrase "wherein the front and rear faces do not overlap.." is indefinite and confusing, and that it is unclear as to how the two faces do not overlap an end of the tape. Although we believe that the phrase is clear, claims 1 and 12 are amended to recite "wherein the front and rear faces are exposed at an end of the continuous elongated flexible tape body". As noted herein above, this amendment is supported by the drawings. For example, FIGs. 6 and 7 show front and rear faces exposed at an end of the tape body.

Regarding claim 30, the Examiner states "the "release tape" is found to be confusing. Could it be the release liner?" Final Office Action, Item 9, p. 4. In response, we note that the instant application does not mention a "release liner". The Examiner is respectfully directed to paragraphs [0068] – [0070], FIG. 12 and FIG. 13, which describe and show release tape 114,

which serves to "protect the surface of pavement tape adhesive 112 ." Specification, p. 10, ¶[0069]. Should confusion persist regarding this or other issues, we encourage the Examiner to telephone the undersigned attorney.

#### 10. Claim Rejections – 35 U.S.C. §102

Claims 1-5, 7-8, 11-14, 16-17, 19, 28-32 and 34 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,514,655 ("Bastiaens"). We respectfully disagree.

Bastiaens fails to show the identical invention as contained in claims 1-5, 7-8, 11-14, 16-17, 19, 28-32 and 34, and therefore fails under 35 U.S.C. §102(e). For example, contrary to the Examiner's statement, Bastiaens does not teach or show a pavement tape with a front face comprising at least one symbol, as in independent claims 1, 12 and 28. Bastiaens' retroreflective article has "an image 24 on the surface 33 of the binder layer 30 and ...a transparent cover film 46 applied to the image 24. The transparent cover film 46 comprises a transparent film 50 and a pressure sensitive adhesive layer 52. The transparent cover film 46 is typically applied to the image 24 by placing the surface 54 of the adhesive layer 52 in contact with the image 24 and passing the cover film 46 and imaged receptor sheet 18 through the nip of pressure roles, to provide an imaged retroreflective article." Bastiaens' col. 3, lines 24-32; FIG. 4. The front face of Bastiaens' imaged retroreflective article (i.e., transparent film 50) does not, therefore, comprise at least one symbol. Rather, image 24 is beneath the front face, on the binder layer.

Furthermore, we must fervently disagree with the Examiner's statement that Bastiaens "is silent with respect to the phrase 'the front and rear faces do not overlap an end of the tape body' and hence, the two faces do not overlap." Office Action p. 5, item 11. Here, the Examiner essentially states that because Bastiaens is silent as to a claim element, that claim element exists in Bastiaens. Respectfully, this statement is illogical and is improper under 35 U.S.C. §102. It also serves to overcome the Examiner's own rejection. The Examiner recognizes (and we agree) that Bastiaens is silent as to the element of front and rear faces that do not overlap an end of the tape body. Bastiaens therefore does not teach this claim element. Again, per MPEP §2131, Bastiaens must teach every element of the claims in order to establish anticipation.

We have amended claims 1 and 12 to replace the phrase "...wherein the front and rear faces do not overlap an end of the tape body" with "...wherein front and rear faces are exposed at

an end of the tape body". Because the amendment is a positive recitation of the negative limitation, we submit that Bastiaens also fails to teach this element of claims 1 and 12. Bastiaens nowhere mentions exposed front and rear faces of a tape body.

Bastiaens fails to anticipate independent claims 1, 12 and 28, because it does not teach every element of the claims. In particular, Bastiaens fails to teach (a) a front face of a pavement tape comprising at least one symbol, and (b) front and rear faces that are exposed at an end of a tape body. Claims 2-5, 7-8, 11, 12-14, 16-17, 19, 29-32 and 34 depend from claims 1, 12 or 28, and therefore benefit from like argument. However, there are additional reasons for the patentability of claims 2-5, 7-8, 11, 12-14, 16-17, 19, 29-32 and 34, including the following:

Claims 4, 13 and 31: Bastiaens does not teach a protective tape, one face of which is releasably bonded to a front face of a pavement tape. The Examiner contends that in Bastiaens, "The front face is provided with the information print and is covered by a transfer tape (7) that is understood to be releasably bonded to said front face." Final Office Action, p. 5, item 11. Respectfully, Bastiaens recites a transfer sheet, not a tape. Bastiaens recites that the transfer sheet and a receptor sheet pass through rollers of a printer, "where heat and pressure are applied to transfer the toned image 24 from the image transfer sheet web 28 to the surface 33 of binder layer 30" col. 3, lines 15-18. This is image transfer, not releasably bonding. Further, Bastiaens is completely silent as to any protective function, and therefore fails to anticipate claims 4, 13 and 31.

Claims 7, 16 and 34: As noted, Bastiaens does not teach a pavement tape with a front face comprising a symbol. Furthermore, Bastiaens does not teach a pavement tape wherein at least part of such symbol is reflective. Bastiaens recites a retroreflective article with an image on the surface of a base material, wherein "the surface of the base material comprises a binder layer of polyvinyl butyral resin having glass microspheres enclosed therein and a specular reflective layer underlying and spaced apart from the microspheres by the resin." col. 1, lines 53-55; see also FIG. 2 and col. 2, line 63 - col. 3, line 4. An image is then transferred to this base material, in particular, "to the side of the base material closest to the microspheres and opposite the reflective layer." Bastiaens, col. 4, lines 34-35. This is different from a reflective symbol on a front face. Bastiaens' image itself is not described as reflective. Because Bastiaens does not teach an at least partially reflective symbol, no anticipation can be found.



Claims 8, 17 and 34: Likewise, Bastiaens does not teach a tape having a front face with at least one symbol, wherein at least part of the front face is reflective. As noted, Bastiaens' article is reflective due to glass microspheres enclosed in a binder layer and a specular reflective layer underneath the binder layer. A transparent cover film is applied over the binder layer. See Bastiaens' col. 3, lines 24-32; FIG. 4. The front face (e.g., the cover film) of Bastiaens' final product is described throughout the Bastiaens patent as clear, not reflective. See, e.g., Bastiaens col. 1, lines 60-63; col. 3, lines 16-18. Bastiaens therefore fails to anticipate claims 8, 17 and 34.

Claims 11 and 19: We strongly disagree with the Examiner's finding that "the railing is not found to be of positive limitation as it is attached to the intended use pavement and not part of the claimed tape." Final Office Action, page 6. Claims 11 and 19 clearly state "The pavement tape... further comprising at least one railing". We contend that the limitation thus has patentable weight. However, in an effort to advance the prosecution of this application, claims 11 and 19 are amended to clarify that the railing is attachable to pavement and configured for protecting at least one edge of the pavement tape.

Bastiaens is completely silent as to any railing. Therefore, the reference fails to anticipate claims 11 and 19.

We have demonstrated that Bastiaens does not anticipate claims 1-5, 7-8, 11-14, 16-17, 19, 28-32 and 34. Withdrawal of the Examiner's rejection under 35 U.S.C. §102(e) is therefore respectfully requested.

#### 11-12. Claim Rejections – 35 U.S.C. §103

The Examiner next rejects claims 6, 15 and 33 as being unpatentable in view of Bastiaens. Specifically, the Examiner states that it would have been obvious to provide a tape having a width of 6-12 inches. Respectfully, as shown above, Bastiaens fails to teach or suggest a pavement tape with a front face comprising a symbol. Bastiaens thus fails to teach or suggest all of the limitations of claims 1, 12 and 28 and cannot render these claims *prima facie* obvious, per MPEP, §2142. Claim 6 depends from claim 1, claim 15 depends from claim 12 and claim 33 depends from claim 28. A *prima facie* case of obviousness is therefore not established over these claims; we thus request withdrawal of the §103 rejection.

### 13. Allowable Subject Matter

We thank the Examiner for the indication of allowable subject matter in claims 9, 10, 18 and 35. We concur that the prior art fails to teach (a) the presence of at least one symbol formed as a perforation or (b) a flexible mask tape having at least one symbol formed as a perforation extending from its front face to its rear face, the tape bonded to the front face of the pavement tape. However, as argued herein above, we believe that all currently pending claims are allowable over the cited references.

### 14. Conclusion

We contend that the Office Action mailed August 9, 2005, is prematurely final. We therefore request withdrawal of the finality of said Office Action.

The cited prior art does not teach or suggest each limitation of claims 1-19 and 28-35. The references thus fail under 35 U.S.C. §§102-103. We respectfully request withdrawal of each of the Examiner's rejections and objections, and we solicit a Notice of Allowance for all of claims 1-19 and 28-35.

We again specifically request to interview this case should any issues remain outstanding. The Examiner is therefore encouraged to telephone the undersigned attorney should this occur and prior to any further Office Action.

No fees are believed currently due; however, if any fee is deemed necessary in connection with this Rule 116 Amendment and Response, the Commissioner is hereby authorized to charge Deposit Account No. 12-0600.

Respectfully submitted,

LATHROP & GAGE L.C.

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